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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,491	07/16/2004	Albrecht Otto	PC10444US	5703

7590 05/31/2005
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EXAMINER

BURCH, MELODY M

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/502,491	Applicant(s) OTTO ET AL.	
	Examiner Melody M. Burch	Art Unit 3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/16/04</u> . | 6) <input type="checkbox"/> Other: _____ |

ML

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

3. Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over applicant's signature providing a complete post office address is required. Examiner has interpreted the address given as being the residence although the address is not labeled as such.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the electric change-over valve recited in claim 13, the inlet and outlet valves recited in claim 13, the separating valve recited in claim 14, the inlet valve recited in claim 15, and the non-return valve recited in claim 19, and the accumulator accommodating bore in the second row of valves as recited in the last two lines of claim 20 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: element W shown in figure 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the

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filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 13-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re: claim 13. The phrase "outlet valves" in line 17 of claim 13 is indefinite. It is unclear to the Examiner whether the outlet valves of line 17 are intended to be the same or different from the outlet valves recited in line 3 of claim 13. Examiner recommends

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the use of the phrase --the outlet valves-- if Applicant intends to refer back to the previously recited valves.

Re: claim 14. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 14 recites the broad recitation a channel, and the claim also recites preferably a transverse channel which is the narrower statement of the range/limitation.

Re: claim 15. Similarly, the phrase "an inlet valve" in the last two lines of the claim is indefinite. It is unclear to the Examiner whether the inlet valve in claim 15 is intended to be the same or different from one of the inlet valves recited in claim 13. A similar issue exists with the limitation of "a valve accommodating bore" in line 4 of claim 15.

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Re: claim 20. The phrase "said channel" in line 3 from the bottom is indefinite. It is unclear to the Examiner whether Applicant intends to refer to the return channel or the suction channel.

Re: claim 20. The phrase "the accumulator accommodating bore in the second row of valves" in the last two lines of claim 20 is incorrect in light of the disclosure. The accumulator accommodating bore is not in the second row of valves. Examiner has interpreted the claim as reading --the accumulator accommodating bore and the second row of valves-- since the return channel 10 is directly adjacent to the second row of valves and the accumulator accommodating bore as shown in figures 1 and 3.

Re: claim 22. The phrase "the valve-accommodating bore" in line 4 is indefinite. It is unclear as to which valve accommodating bore Applicant intends to refer to since a plurality of valve accommodating bores were previously recited.

The remaining claims are indefinite due to their dependency from claim 13.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 13, 14, 18, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO 0100471 (using US Patent 6688707 to Dinkel et al. as an

English equivalent) Dinkel et al. '471 in view of WIPO-9925594 (using US Patent 6398315 to Dinkel et al. as an English equivalent) Dinkel '594.

Re: claim 13. Dinkel et al. '471 show in figure 2 a hydraulic unit for slip controlled brake systems comprising: an accommodating member 1 accommodating inlet and outlet valves in several valve accommodating bores of a first and second row of valves (the first row extending parallel to left element 9 and the second row extending parallel to right element 2' and element VL) that open into a first or bottom housing surface of the accommodating member which is positioned at an angle relative to a second housing surface, opening into whose area preferably several braking pressure generator ports and or wheel brake ports VR,VL, a pump accommodating bore 3 arranged in the accommodating member and aligned transversely to the direction the valve accommodating bores open into the accommodating member as shown, wherein the pump accommodating bore is arranged between the axes of the valve accommodating bores of the first and second row of valves as shown, a motor accommodating bore 4 arranged in the accommodating member and pointing to the pump accommodating bore as shown, an accumulator accommodating bore opening into the accommodating member transversely to the axes of the valve accommodating bores in a third housing surface that is opposite to the second housing surface as shown, outlet valves arranged in the valve accommodating bores of the second row of valves, wherein in the second row of valves the axes of the valve accommodating bores between the accumulator accommodating bore and the pump accommodating bore point into the accommodating member as shown, and including several channels

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as shown in the area of 5", 3', right 2', etc. interconnecting the valve, pump, and accumulator accommodating bores and being able to provide a hydraulic connection between a braking pressure generator and several wheel brakes to the same extent as Applicant, wherein a third row of valves (shown extending parallel to left element 2' and element VR) is arranged in the accommodating member between the first row of valves including the valve accommodating bores for the inlet valves and the second housing surface, with the third row of valves including at least one valve accommodating bore being hydraulically linked to the pump accommodating bore by way of a portion of a suction channel (left 2', second from the left 2', second from left 5" in one interpretation), (left 2', second from the left 2', second from left 5", 9 in an alternate interpretation), and (left 2' and 9 in an additional interpretation) that transverses the first row of valves for connection to the pump accommodating bore as shown.

Dinkel et al. '471 lack the limitation of the third row of valves including at least in one valve accommodating bore an electric changeover valve which is closed in its basic position.

Dinkel et al. '594 teach in col. 3 lines 49-51 the limitation of the third row Z including at least in one valve accommodating bore an electric changeover valve which is closed in its basic position (Examiner has interpreted the basic position to be the non-initial position in which the valve is closed, as broadly claimed).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified one of the valve accommodating bores of the third row of Dinkel et al. '471 to have included an electric changeover valve, as taught by

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Dinkel et al. '594, in order to provide a means of controlling the blocking pressure for the purpose of traction or vehicle dynamics control as taught by Dinkel et al. '594 in col. 3 lines 44-52.

Re: claim 14. Dinkel et al. '471, as modified, teaches in col. 3 lines 46-48 of Dinkel et al. '594 the limitation of at least one further valve accommodating bore of the third row of valves into which a separating or electromagnetic valve is inserted, (in order to provide a means of controlling the blocking pressure for vehicle control as set forth above) is connected to the valve accommodating bore containing the changeover valve by a channel second from the left 2' extending between the two elements 2 of the third row as shown in the additional interpretation.

Re: claim 18. Dinkel et al. '471, as modified, teach in figure 2 of Dinkel et al. '471 the limitation wherein the pump accommodating bore 3 is penetrated by the suction channel in the direction of the accumulator accommodating bore, with the suction channel, particularly the portion in the area of second from the left element 5", opening into the bottom of the accumulator accommodating bore.

Re: claim 24. Dinkel et al. '471, as modified, teach in figure 2 of Dinkel et al. '471 the limitation wherein adjacent to the valve accommodating bore provided for the change-over valve, a blind end bore shown in the area of the lead line of number left 7 is provided in the accommodating member to accommodate a pump suction damper 7, the blind end bore being connected by way of a pressure channel 9 to the valve accommodating bore receiving the changeover valve via the suction channel left 2' in the alternate interpretation.

11. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO 0100471 in view of WIPO-9925594 as applied to claim 18 above, and further in view of US Patent 5496099 to Resch.

Dinkel et al. '471, as modified, describe the invention substantially as set forth above, but do not include the limitation of a non-return valve opening in the direction of the pump accommodating bore being inserted into the portion of the suction channel which is positioned between the pump accommodating bore and the accumulator accommodating bore.

Resch teaches in figure 1 a non-return valve shown in the area of 128 opening in the direction of the pump accommodating bore being inserted in to a portion of a suction channel shown in the area of element 128 which is positioned between a pump accommodating bore shown in the area of element 129 and an accumulator accommodating bore shown in the area of element 124.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the hydraulic unit arrangement of Dinkel et al. '471, as modified, to have included a non-return valve as recited above, as taught by Resch, in order to provide a means of preventing fluid from leaking back in to the accumulator.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claim 13 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent No. 6877822 to Dinkel et al. in view of WIPO-0100471. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim a hydraulic unit comprising: an accommodating member with inlet and outlet valves, a pump accommodating bore, a motor accommodating bore, an accumulator accommodating bore, first, second, and third rows of valves, an electric change over valve which is closed in its basic position in at least one of the valve accommodating bores of the third row of valves, and a suction channel.

Dinkel et al. '822 lacks the limitation of the suction channel traversing the first row of valves for connection to the pump accommodating bore. WIPO-0100471 teaches in figure 2 the limitation of a suction channel traversing the first row of valves for connection to the pump accommodating bore.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the arrangement of the suction channel of Dinkel et al. '822 in order to provide a means of altering fluid flow through the hydraulic unit

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depending on space limitations and depending on the desired vehicle dynamics control to be achieved.

With regards to the recitation of the closure member in the Dinkel et al. '822 patent the court held that for the purposes of obvious double patenting a later genus (broad) claim is not patentable over an earlier species (narrow) claim.

Allowable Subject Matter

14. Claims 15-17 and 20-23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents: 5975652 to Otto and 3538947 to Leiber teach similar hydraulic units containing valve accommodating ports arranged with respect to various fluid channels.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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May 24, 2005

Melody M. Burch
5/24/05